



JPW

PATENT
Customer No. 22,852
Attorney Docket No. 7707.0023-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Paul TEUFEL et al.) Group Art Unit: 1733
)
Application No.: 10/622,737) Examiner: Aftergut, Jeff H.
)
Filed: July 21, 2003)
) Confirmation No.: 2798
For: METHODS OF DEBONDING A)
COMPOSITE TOOLING)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In a restriction requirement dated September 26, 2005, the Examiner required restriction under 35 U.S.C. § 121 between the following two Groups:

Group I: Claims 1-14, 29, 31-40, 51, 53, and 55 as allegedly drawn to a method of removing a mandrel from a part classified in class 156, subclass 155; and

Group II: Claims 15-28, 30, 41-50, 52, 54, and 56 as allegedly drawn to a system for removing a mandrel from a part classified in class 156, subclass 425.

For the reasons set forth below, Applicants respectfully traverse the Examiner's restriction requirement.

The Examiner argues that the methods of Group I and the apparatus of Group II are distinct because the method as claimed "can be practiced ... by hand." (Restriction Requirement at 2.) In support, the Examiner states that the steps of "applying a

debonding agent on the surface of the mandrel” and “removing the mandrel from the part” may be performed by hand. *Id.* Notably, the Examiner does not state that the claimed step of “creating a vacuum in the part” can also be performed by hand.

Applicants respectfully assert that this step cannot be performed by hand and would require an apparatus, such as that claimed in the inventions of Group II. Therefore, the inventions of Groups I and II are not distinct on this basis.

The Examiner also argues that the inventions of Group I and II are distinct because “the apparatus as claimed can be used to practice another and materially different process.” (Restriction Requirement at 2.) In support, the Examiner states that the apparatus could be used to apply an interior coating on the part wherein resin is applied to the interior of the composite part. *Id.* The Examiner has provided no evidence, however, that such an apparatus is materially different from that claimed by the Applicants. The Examiner has merely stated that the apparatus may be used to apply a different substance to the part. Absent a showing of material difference, the restriction requirement is also improper on this basis. MPEP § 806.05(e). Therefore, the inventions of Groups I and II are also not distinct on this basis.

Finally, there must be a serious burden on the Examiner to examine the claims in one application in order for restriction to be appropriate. MPEP § 803. The claims of Groups I and II would not require substantial additional searching by the Examiner due to the similarity in the claims. For example, claim 1 of Group I recites: “A method of removing a mandrel from a part, comprising: creating a vacuum in the mandrel; applying a debonding agent on the surface of the mandrel; and removing the mandrel from the part,” while claim 15 of Group II recites: “A system for removing a mandrel from a part,

comprising: a creating component configured to create a vacuum in the mandrel; an applying component configured to apply a debonding agent on the surface of the mandrel; and a removing component configured to remove the mandrel from the part.” The similarity of these claims demonstrates that no serious burden exists in examining these claims together.

In addition, the Examiner has classified all of the claims in the same class, i.e., class 705. Because the Examiner has not shown separate classification or separate fields of search, Applicants submit that no serious burden would result from examining all of the claims together. “If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits....” MPEP § 803. Finally, requiring restriction would result in unnecessary delay in examination and added cost to Applicants. Therefore, Applicants respectfully request that the Examiner withdraw the restriction requirement.

Should the Examiner continue to assert that the inventions are distinct, Applicants provisionally elect to prosecute Group I, claims 1-14, 29, 31-40, 51, 53, and 55.

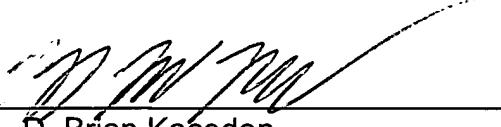
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 26, 2005

By: _____


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